

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1, 3-6, 23, and 26-31 are pending in the present application. Claims 1 and 23 have been amended. Support for amended claims 1 and 23 may be found in the original claims and generally throughout the specification. In particular, support may be found at page 3, line 14, to page 5, line 4; and Table 1 beginning on page 7. Claims 26-31 have been added. Support for claims 26-31 may be found in original claims 1, 3-6, and 23, and in the present specification at Table 1 beginning on page 7. Claims 1, 2, 7-22 and 24-25 have been canceled.

In the outstanding Official Action, claims 1, 5, and 23 were rejected under 35 USC §102(b) as allegedly being anticipated by HOELTJE et al. The Official Action stated that HOELTJE et al. teach a compound wherein R₁ is i-Pr and R₂ is H or Me. However, independent claims 1 and 23 have been amended to recite that when R₁ is H, Me, or i-Pr; R₂ is not H, Me, or i-Pr. As a result, applicants believe that this rejection has been obviated.

Claim 11 was rejected under 35 USC §101 for allegedly claiming the same invention as that of claim 22 in U.S. Patent No. 6,734,292. Applicants believe the present amendment obviates this rejection.

Claims 1, 3, 4 and 23 were rejected under 35 USC §103(a) as allegedly being unpatentable over HOELTJE et al., GIDDA et al., or KIRST et al. This rejection is respectfully traversed.

Applicants respectfully submit that HOELTJE et al., GIDDA et al., or KIRST et al. each fail to disclose or suggest the claimed invention. In imposing the rejection, the Official Action alleges that since ethyl is a next higher homologue of methyl, a person of ordinary skill in the art at the time the application was filed would have been motivated to substitute ethyl for methyl.

However, as the Examiner is aware, the question as to whether a chemical compound is obvious is a problem of law, not of chemistry. Indeed, the "structural obviousness" of a compound to a chemist does not preclude its patentability when it possesses properties which render it unobvious. *In re McLamore*, 379 F. 2d 985, 154 USPQ 114 (CCPA 1967). In particular, the test for the patentability of a compound that may be a homologue of a prior compound is whether the claimed compound possesses beneficial characteristics which are unexpected and unobvious. *Sterling Drug Inc. v. Watson*, Comr. Pats. 135 F. Supp. 173, 108 USPQ 37 (DCDC 1955).

HOELTJE et al. is directed to a compound that exhibits a beneficial effect on the gastrointestinal tract (col. 1, lines 35-42). KIRST et al. teach a compound with conventional

antibiotic properties (col. 1, lines 10-25). Similar to HOELTJE et al., GIDDA et al. teach a compound and method for treating gastrointestinal disorders (col. 1, lines 1-10). None of the publications disclose or suggest a compound that promotes the differentiation/induction of monocytes to macrophages.

Moreover, none of the publications suggest to one of ordinary skill in the art to modify their compounds in a manner so as to obtain the claimed compounds.

Thus, in view of the above, applicants believe that the publications, alone or in combination with each other, fail to render obvious the claimed invention.

Claims 1, 5, 6 and 23 were rejected under 35 USC §103(a) as allegedly being unpatentable over HOELTJE et al. This rejection is respectfully traversed.

The Official Action alleges that since n-propyl is an isomer of isopropyl, one skilled in the art at the time the application was filed would have been motivated to substitute n-propyl for isopropyl in the publication.

However, isomerism alone is not sufficient basis for a holding of obviousness if the evidence as a whole establishes an unobvious improvement over the prior art. *National Distillers and Chemical Corp. v. Ladd, Comr. Pats.*, 233 F. Supp. 917, 143 USPQ 59 (DCDC 1964). Indeed, as noted above, HOELTJE et al. is directed to the compound that exhibits a beneficial effect on the gastrointestinal tract (col. 1, lines 35-42). HOELTJE et al.

fail to disclose or suggest a compound which promotes the differentiation-induction of monocytes to macrophages.

Thus, it is believed that the claimed compound possesses nonobvious and unexpected beneficial property not possessed by the prior art compound. As a result, applicants believe that HOELTJE et al. fail to disclose or suggest the claimed invention.

In the outstanding Official action claim 23 was rejected under 35 USC §112, first paragraph, for allegedly not satisfying the enablement requirement. Applicants believe the present amendment obviates this rejection.

The Official Action stated that the specification did not describe what is meant by the term "substituents". As a result, applicants did not believe the claim was enabled by the present disclosure. However, this term has been deleted from the claim. As a result, applicants believe that the term is definite to one skilled in the art.

Claims 1 and 23 were also rejected under 35 USC §112, first paragraph, for allegedly not complying with the enablement requirement. The Official action alleged that the terms "alkyl, alkynyl and acyl" lack enablement.

However, the Examiner is respectfully reminded that it is a well founded principle that any assertion by the Patent Office that the enabling disclosure is not commensurate in scope

with the protection sought must be supported by evidence or reasoning substantiating the doubt so expressed.

As a matter of law, the expressed teaching of the patent specification cannot be controverted by mere speculation and unsupported assertions on the part of the Patent Office. As stated by the Court of Customs and Patent Appeals in the case of *In re Dinh-Nguyen and Stanhagen*, 181 USPQ 46 (CCPA 1974):

Any assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by evidence or reasoning substantiating the doubt so expressed. 181 USPQ at 47.

Such a standard must be applied with great care when the Examiner's conjecture is contrary to the teachings of the specification.

In view of the above, applicants believe that the Official Action fails to satisfy its burden in showing that the present disclosure is not enabling for the claimed invention.

Moreover, the Examiner is reminded that the amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art, as well as the predictability in the art. *In re Fisher*, F. 27 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. While the Official Action contends that one of

ordinary skill in the art at the time the invention was made would not have expected a compound substituted by, for example, an alkyl having three carbon atoms to have similar activity to a compound substituted by an alkyl having 20 carbon atoms, applicants respectfully submit that one of ordinary skill in the art would have taken this into consideration upon reviewing the present disclosure.

With this in mind, a disclosure is enabling, even if considerable amount of experimentation is involved, but is merely routine. *Ex parte Formal et al.* 230 USPQ 546 (BPAI 1986). Thus, even if some experimentation was involved to make the claimed invention, applicants do not believe that it would be unduly extensive.

In view of the above, applicants respectfully submit that the present disclosure satisfies the enablement requirement for claims 1, 3-6, 23, and 26-31. In particular, the Examiner's attention is respectfully directed to new claims 26-31, wherein the compounds set forth in the claims recite specifically identified substituent groups in the examples of the present specification.

Claims 4, 6, and 23 were rejected under 35 USC §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants believe the present amendment obviates this rejection.

The Office Action states that the term "monocytes" was misspelled in claim 23, line 2. As suggested by the Examiner, the term has been corrected.

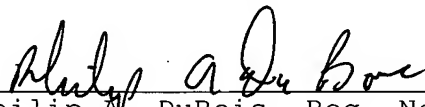
As to claims 4 and 6, the spacing of the amendment provides no special meaning and is believed to be definite to one skilled in the art. As a result, applicants believe that they are definite to one skilled in the art.

Thus, applicants believe that the present application is now in condition for allowance at the time of the next Official Action, with claims 1, 3-6, 23, and 26-31, as presented. Allowance and passage to issue on that basis is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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